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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,126	01/19/2001	Jonathan E. Lowthert	BJA.0012US	9474
21906	7590	06/05/2007		
TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			EXAMINER NGUYEN, HUY THANH	
			ART UNIT	PAPER NUMBER
			2621	
			MAIL DATE	DELIVERY MODE
			06/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/766,126		LOWTHERT ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	HUY T. NGUYEN		2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-23 and 25-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-20, 29-37 and 39 is/are allowed.
- 6) ☒ Claim(s) 21-23, 25-28 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 21-24, 27-28 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison (5,815,671) in view of Goldman et al (7,051,351).

Regarding claim 21, Morrison discloses a system (Figs.1, 2, column 4, lines 35-61) comprising:

a receiver to receive content and an info segment including an interruption point specifier which identifies a location in said content to insert an advertisement;

a cache coupled to said receiver to store said content and said info segment; and an interface, in said receiver, to find the location in said content, identified by said info segment, to insert an advertisement (commercial message) (Figs 4-6, columns 6-8).

Morrison does not teach using a parameter for controlling the displaying of the advertisement at a timing unknown at the time the info segment associated with program identifications. Goldman teaches an apparatus using information for displaying advertisement at a timing unknown at the time info segment associated with the program identification (column 13, lines 45-60, Figs. 3C).

It would have been obvious to one of ordinary skill in the art to modify Morison with Goldman by providing info segment with information to displaying the advertisement at a timing unknown at the time info segment associated with the program identification as additional information of the info segment for an alternative display the advertisement.

Regarding claim 22, Morison further teaches the system of claim 21 wherein said receiver is a television receiver (figs. 1,2).

Regarding claim 23, Morrison further teaches the system of claim 21 wherein said receiver to receive an info segment including a content identifier to associate the info segment with a content item while stored in said cache (column 5, lines 1-28, column 9).

Regarding claim 24, Morison further teaches the system of claim 23 wherein said interface to find a content item identified by said content identifier while stored in

said cache and to find the location, identified by said interruption point specifier, in the cached content to insert an advertisement (columns 6-9, Figs. 5-6).

Regarding claims 27 and 32, Morrison further teaches the receiver to receive an info segment including an ad type specifier to prevent an advertisement from interrupting a content item if the advertisement meets a predetermined criterion (column 10).

Regarding claim 28, Morrison further teaches the receiver to receive an info segment including an ad lock specifier to permit an advertisement to be skipped if a predetermined criterion is met (column 10).

Regarding claim 38 Morrison further teaches the receiver detects a usage command since the Morrison receiver can replay the stored content and advertisement .

3. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison (5,815,671) in view of Goldman as applied to claim 21 above further in view of Seet et al (6,725,203).

Regarding claim 25 , Morrison fails to teaches a maximum interruption length specifier .

Seet teaches an apparatus for displaying advertisement , the advertisement having a maximum length specifier ( advertisement display time length )(Fig. 5) .

It would have been obvious to one of ordinary skill in the art to modify Morrison with Seet by providing the advertisement display time information as a maximum

interruption length specifier to each of ad of Morrison thereby allowing accurately control the access the advertisement .

Regarding claim 36, Morrison as modified with Seet further teaches controlling inserting an advertisement in said content only if said content is selected for play less than a predetermined number of times (See Morison column 60 to column 10, line 50, Seet , column 16, lines 25-35).

4. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison in view of Goldman as applied to claim 21 above further in view of Rakavy et al (5,913,040) .

Regarding claim 26 , Morison fails to teach using resume indicator for overriding play of the advertisement .

Rakavy teaches an apparatus for a play advertisement and having means for overriding a play of a advertisement by disable displaying an advertisement (column 10 lines 35-41). It would have been obvious to one of ordinary skill in the art to modify Morrison with Rakavy by using the teaching of Rakavy for generating a resume indicator for overriding the play of the advertisement thereby enabling the user controls the play of advertisements .

### ***Response to Arguments***

5. Applicant's arguments filed 23 February 2007 have been fully considered but they are not persuasive.

Applicant argues that Morison as modified with and Goldman does not teach Furthermore, there is nothing in Goldman that teaches or suggests that user profile information (or ad selection criteria) includes an interruption point specifier that specifies a condition that if detected by a receiver will cause the receiver to display an advertisement in place of a particular content item. That is, the user profile information and ad selection criteria have nothing to do with identifying the timing of when an advertisement will be displayed. In response it is noted that applicant argues that claim 21 does not reflect the claim 21 since nowhere claim 21 does it suggest using a user profile to control the display of the advertisement.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.N

HUY T. NGUYEN  
PRIMARY EXAMINER